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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,415	02/05/2002	Mattia De Dominicis	108910-00051	4132

7590 05/16/2005

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EXAMINER

TUROCY, DAVID P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

VW

Office Action Summary	Application No.	Applicant(s)	
	10/062,415	DE DOMINICIS ET AL.	
	Examiner	Art Unit	
	David Turocy	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,7,11,18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8-10,12-17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species B, claims 1-2, 5, 8-10, 12-17, and 20 in the reply filed on April 6, 2005 is acknowledged. The traversal is on the ground(s) that all the species presented have the same technical feature; specifically each provides metals with anti-calciferous properties. This is not found persuasive because each of the species is patentably distinct from each other.

The requirement is still deemed proper and is therefore made FINAL.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 5, 8-10, 12-17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1006168 by Visca et al, hereafter Visca.

Claim 1: Visca teaches applying a bifunctional polyfluoropolyether phosphoric ester compound to the surface of various substrates, including metal (Abstract, Paragraph 0007). Visca discloses using a compound, see formula III and specifically example 3, that corresponds to the elected species (B) (Paragraph 0011, 0043).

Claims 2, and 12-17: The bifunctional polyfluoropolyether phosphoric ester compound as disclosed by example 3 meets all the limitations of these claims.

Claim 5, 8-9 and 20: Visca discloses applying a 2% by weight bifunctional polyfluoropolyether phosphoric ester compound in a mixture of water/isopropanol by brushing (Paragraph 0043).

Claim 10: Visca teaches of providing metal substrate with water repellency characteristics, which results in conferring a certain amount of anti-corrosive properties (Abstract).

Visca does not explicitly disclose conferring anticalcar properties to a metal substrate, however it is the examiners position that such a characteristic is inherent. The prior art and the present claims, reflected by claim 1, teach all the same process steps and thus the results obtained by applicants process must necessarily be the same as those obtained by the prior art. Therefore by applying a bifunctional polyfluoropolyether phosphoric ester compound to a metal substrate, it must necessarily

Art Unit: 1762

result in conferring anticalcar properties. Either 1) the applicant and the prior art have different definitions for applying to a metal substrate a bifunctional polyfluoropolyether phosphoric ester compound, or 2) the applicant is using other process steps or parameters that are not shown in the claims.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6184187 by Howell et al. discloses phosphorus compounds and their use as corrosion inhibitors.

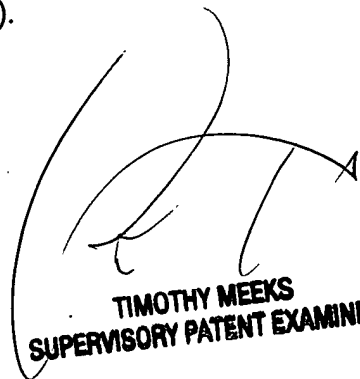
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy
AU 1762



TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER